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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/998,340 | 12/03/2001 | Kaoru Torikoshi | 111243 | 5573 |

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT PAPER NUMBER

1774

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,340

Applicant(s)

TORIKOSHI, KAORU

Examiner

Betelhem Shewareged

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 5-12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 15 is/are allowed.
- 6) ☒ Claim(s) 1-3, 13, 14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/06/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's Request for Continued Examination (RCE) has been fully considered. Claims 2, 4 and 15 are amended, claim 16 is added, and thus claims 1-16 are pending. (NOTE: Claims 5-12 are withdrawn from consideration as non-elected invention).

Claim Rejections - 35 USC § 102

2. Claims 1-3, 13, 14 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Sarkar et al. (US 6,465,081 B2).

Sarkar discloses an image receptor sheet comprising a substrate having two opposite sides, an ink receptive layer on one side of the substrate, and an ink repellent layer on the other side of the substrate, wherein the ink repellent layer is toner powder receptive so as to allow the image receptor sheet to be used in electrophotographic printers (col. 3, lines 22-32). The side of the substrate that has the ink repellent layer is equivalent to the claimed side of the substrate that the electrophotographic image is being formed. The ink receptive layer is equivalent to the claimed characteristic controlling member. The substrate and the coated layers are transparent (col. 3, line 41 and claims 3 and 8). The ink receptive layer comprises resin and filler as the claimed characteristic controlling member (col. 5, line 60 thru col. 6, line 16). Since the ink receptive layer is substantially identical to the claimed characteristic controlling member, the layer inherently functions as glossiness controlling layer that reduces glossiness. Since all the three layers are transparent, an image that may be provided on the ink repellent toner receptive layer can be seen when viewed through the substrate.

Response to Arguments

3. Applicant's argument is based on that since the fillers of Sarkar do not compromise the transparency of the ink receptive layer the fillers of Sarkar do not control the glossiness of the ink receptive layer. These arguments are not persuasive because Sarkar does not expressly disclose that the ink receptive layer *does not control glossiness*. However, because the ink receptive layer is substantially identical to the claimed characteristic controlling member (i.e., the fillers and the resin that are used to make the ink receptive layer are substantially identical to the fillers and the resin that are used to make the claimed characteristic controlling member of the claimed invention), the layer inherently functions as glossiness controlling layer. Furthermore, Applicant is advised to provide factual evidence showing that the addition of fillers in the ink receptive layer while not compromising the transparency of the layer does not affect the glossiness of the layer.

Applicant further argues that the amount of microspheres used in the examples of Sarkar is too small; therefore, glossiness cannot be controlled. This argument is not persuasive because the claimed invention is not limited to a certain amount of fillers, and also the invention of Sarkar is not limited to the examples disclosed.

Allowable Subject Matter

4. Claims 4 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Sarkar neither teaches nor suggests

mechanical treatment of the surface of the substrate opposite the ink repellent toner receptive layer in order to control the glossiness of the image recording sheet.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Betelhem Shewareged
November 22, 2004.